

REMARKS

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing amendment, claims 1-19, 21-28, 31-41, 43-55 and 57-65 are pending in this application with claims 1, 10, 19, 22, 26, 31, 32 and 43 being the independent claims. The Applicants respectfully request that the Examiner reconsider and withdraw all outstanding rejections. The Applicants further request that the Examiner enter the amendments to the claims at least for purposes of placing the application in better condition for appeal.

Claim Rejections Under 35 U.S.C. 112

Claims 1, 10, 22 and 31 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that the specification does not support the recitation that the “toolbar is fixedly disposed on said touch screen.” The Applicants have amended claims 1, 10, 22 and 31, amending the “fixedly disposed” recitation to address this rejection. Accordingly, the Applicants request that the Examiner withdraw the rejection of claims 1, 10, 22 and 31 under 35 U.S.C. § 112, first paragraph.

Claim 64 was also rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that the claim recitation that the second activity is a game activity has not been disclosed in such a manner as required by claim 64 wherein the “game is the second activity that is made available or unavailable and dependent on the selection of a first activity.” The Applicants do not agree with this assertion. The Applicants respectfully submit that claim 64 depends from claim 22 which recites “retrieving a second activity application from a removable read-only memory cartridge” and “the second characteristic being configured to interact with the retrieved second activity application from the removable read-only memory cartridge, and not the first activity application.” This recitation does not say that the second activity is made available or unavailable and dependent on the first activity as asserted by the Examiner, rather, claim 22 recites that the second *characteristic* is configured to interact with the second activity and not the

first activity. Claim 64 then further recites that the second activity is a gaming activity. Claim 64 is supported in the specification for example, at page 8, par. [1035], which states “various other activities can be provided using expansion cartridges 130. For example, expansion cartridges 130 can be provided that enable game activities . . .” Further support can be found, for example, at page 6, par. [1027], which states “[t]hese activities may be supported by the base system software or may be supported by expansion cartridge 130” and “[w]hile the particular application of the tools to the various activities can vary, the core functional aspect of the tools themselves will be left relatively unchanged.” Thus, as in claim 22, a first characteristic associated with an icon on the toolbar can be configured to interact with a first activity supported, for example, by the system software, and a second characteristic associated with that icon can be configured to interact with a second activity supported by the expansion cartridge, but not be configured to interact with the first activity (e.g., supported by the system software). Claim 64 merely recites that that second activity retrieved from the expansion cartridge is a gaming activity, which as pointed out above is supported by the specification. Accordingly, the Applicants respectfully request that the rejection of claim 64 under 35 U.S.C. § 112 be withdrawn.

Claim 1 was further rejected under 35 U.S.C. § 112 as having insufficient antecedent basis. Specifically, the Examiner asserts that the limitation “said plurality of activities” has no prior reference in the claim. The Applicants have amended claim 1 to address this rejection and request that the rejection of claim 1 under 35 U.S.C. § 112 be withdrawn.

Claim Rejections Under 35 U.S.C. 103 (a)

Claims 1-19, 21-28, 31-41, 43-55 and 57-66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. US 2001/0038999 by Hainey, II (“Hainey”) in view of Microsoft Office Shortcut Bar (“Microsoft Office”) and Microsoft Paint, copyright 1981-1998 version 4 (“Microsoft Paint”) and further in view of the publication “SAMS Teach Yourself Paint Shop Pro 5” by Michael T. Clark (“Clark”).

Claim 1 and its Dependent Claims

Claim 1 recites “said second interactive tool being one of activated or inactivated based on the selection of said one of said plurality of drawing activities.” None of Hainey, Microsoft Office, Microsoft Paint, or Clark, alone or in combination, disclose or suggest such a device.

Specifically, none of the cited references, alone or in combination, disclose or suggest a “second interactive tool [from a tool bar] being one of activated or inactivated based on the selection of said one of said plurality of drawing activities.” The hand-held device of the present application can be used for different types of drawing activities, as well as gaming activities. The tool bar is disposed on the device, and the interactive tools (although remaining displayed on the device) may or may not be activated (e.g., turned on) for use with a given activity.

For example, as described in the specification, the interactive tools of the hand-held device can be configured such that they are activated and thus available for use with some activities, but not with others. For example, once an activity is selected by a user, the device can activate some or all of the interactive tools to be used with that activity. As one example, if a free-drawing activity is selected, the interactive tools associated with the icons 201-209 on the toolbar menu can be activated (i.e., turned on or made available for use). If the user selects a concentration-game activity, the interactive tools associated with some of the icons 201-209 may be inactivated (i.e., turned off or made unavailable). *specification*, par. [1036]. Thus, none of the cited references disclose or suggest that an interactive tool on a toolbar can be activated or inactivated based on the selection of an activity.

The Examiner asserts on page 4 of the Office Action that Hainey teaches “said second interactive tool being one of activated or inactivated based on the selection of said one of said plurality of drawing activities” and refers to paragraph [0035] of Hainey. The Examiner states that Hainey “teaches that when a player selects an icon, additional menus or second interactive tools become available for selection from the selection of the first icon [0035].” The Applicants submit that the Examiner has failed to show that the limitation “said second interactive tool

being one of activated or inactivated based on the selection of said one of said plurality of drawing activities” is disclosed by Hainey. Paragraph [0035] of Hainey is reproduced below:

[0035] In use, an individual operates the portable, hand-held drawing instruction device as shown in FIG. 3, by entering data via the touch-sensitive screen 13 or the input buttons on the device. Various commands may be activated by touching icons 27 displayed on and around the screen 13 with the stylus 25 or other suitable implement for interacting with the touch-sensitive screen. Each icon selected opens a window, which preferably remains open until a further selection is made, or until the touch-sensitive screen is touched again, providing further options available within the selected category. Confirmation of an operation may be achieved by pressing the external command button on the unit or selecting an appropriate option from the touch-sensitive screen. A [figure] may be entered by selecting from a variety of simulated drawing tools selected from a menu and using the stylus to enter the figure on the touch sensitive screen. Such simulated drawing tools can include, but are not limited to, a pencil, a paintbrush, a spray paint can, an eraser, or other suitable tool for creating artwork.

The Applicants submit that the limitation recited in claim 1, “said second interactive tool being one of activated or inactivated based on the selection of said one of said plurality of drawing activities,” is not described in paragraph [0035] of Hainey or in any other portion of Hainey. Although Hainey teaches that selection of the icons 27 will bring up menus and submenus available for selection (as mentioned by the Examiner), Hainey does not teach or suggest that any of the icons 27 can be made to be activated or inactivated based on a selection of an activity. For example, Hainey does not disclose or suggest a first icon from icons 27 that allows the selection of a first activity and then based on that selected activity, a second one of the icons 27 is either activated or inactivated. Rather, all the selectable icons 27 of Hainey are available regardless of which activity is being selected. This is also true for the other cited references. Thus, the Examiner has failed to show that the limitation “said second interactive tool being one of activated or inactivated based on the selection of said one of said plurality of drawing activities,” has been met by the prior art.

It is further noted that the Applicants are not merely attacking the references individually as previously suggested by the Examiner, but rather, the Applicants are pointing out that none of the references disclose or suggest “said second interactive tool being one of activated or inactivated based on the selection of said one of said plurality of drawing activities,” as recited in

claim 1. Thus, the recitation “said second interactive tool being one of activated or inactivated based on the selection of said one of said plurality of drawing activities,” is entirely missing from the cited prior art.

Accordingly, for at least this reason, claim 1 is allowable over the cited references. Based at least upon their dependence from claim 1, claims 2-9, 52 and 65 are also allowable.

Claim 10 and its Dependent Claims

Claim 10 has been amended to recite “at least one of said plurality of interactive tools being a full screen erase tool that includes a plurality of selectable animated full-screen erase options.” None of Hailey, Microsoft Office, Microsoft Paint, or Clark, alone or in combination, disclose or suggest such a device. The Examiner asserts relative to now canceled claim 66 (the subject matter of which has been added to claim 10 by this amendment) that “the prior art is silent regarding the full screen erase function having selectable animated erase options,” but states that “it is notoriously well known in the art to allow users to select their animation options and therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to allow users to select an animation for which to view while the system erases their screen.”

The Applicants submit that the Examiner is using impermissible hindsight to make an unsupported conclusory statement that such a feature is well known in the art. For example, merely stating that “it is notoriously well known in the art to allow users to select their animation” does not adequately or fully explain how the “full screen erase tool that includes a plurality of selectable animated full-screen erase options” as recited in claim 10 is known in the art. Thus, the Applicants submit that the Examiner has not met his burden of showing obviousness of claim 10 (previous claim 66).

Accordingly, at least for this reason, claim 10 is allowable over the cited references. Based at least upon their dependence from claim 10, claims 11-18 and 53 (claim 66 is canceled) are also allowable.

Claim 19 and its Dependent Claims

Claim 19 recites “the selected interactive tool being one of activated or inactivated based on the selected one activity from the plurality of activities.” For similar reasons as stated above for claim 1, none of Hainey, Microsoft Office, Microsoft Paint, or Clark, alone or in combination, disclose or suggest such a method. Specifically, none of the cited references disclose or suggest interactive tools (associated with a selectable icon in a toolbar) that are configured to be activated or inactivated based on a selected activity.

Accordingly, at least for this reason, claim 19 is allowable over the cited references. Based at least upon their dependence from claim 19, claims 21 and 54 are also allowable.

Claim 22 and its Dependent Claims

Claim 22 recites “retrieving a second activity application from a removable read-only memory cartridge for display on the hand-held electronic toy” and “the second characteristic being configured to interact with the retrieved second activity application from the removable read-only memory cartridge, and not the first activity application.” None of Hainey, Microsoft Office, Microsoft Paint, or Clark, alone or in combination, disclose or suggest such a method.

Specifically, none of the cited references disclose or suggest a method that includes determining a characteristic of a selected interactive tool that is configured to interact with an activity application retrieved from a read-only memory cartridge and not interact with a first activity application retrieved from a different memory.

The Examiner asserts that “Hainey teaches that the memory cartridge can add additional lessons for the user to select (second activity applications) when additional cartridges are inserted [0031].” The Applicants submit that although this assertion may be true, this is not the same as what is recited in claim 22. Claim 22 recites that there is a characteristic of a selected interactive tool (associated with an icon on a toolbar) that is configured to interact with an activity application retrieved from a read-only memory cartridge, but not interact with a first activity retrieved from a different memory. As stated by the Examiner, Hainey describes the use of cartridges to enable additional and updated art lessons and other media content, but it does not

disclose or suggest that any of the icons 27, menus, submenus or characteristics thereof are configured to interact with an activity retrieved from one memory (e.g., a cartridge), but cannot interact with an activity retrieved from another different memory.

Accordingly, at least for this reason, claim 22 is allowable over the cited references. Based at least upon their dependence from claim 22, claims 23-25, 55, 63 and 64 are also allowable.

Claim 26 and its Dependent Claims

Claim 26 recites “displaying a plurality of selectable starter scenes on the touch-screen display of the hand-held electronic toy based on a selection of one drawing activity from said plurality of drawing activities” and “upon receipt of a selection of a starter scene from said plurality of selectable starter scenes modifying at least one characteristic associated with an interactive tool on a toolbar from a first state to a second different state based on the selection of said starter scene.” None of Hainey, Microsoft Office, Microsoft Paint, or Clark, alone or in combination, disclose or suggest such a method.

Specifically, none of the cited references disclose or suggest a method that includes varying a characteristic associated with an interactive tool on a toolbar based on the selection of a starter scene from a selection of starter scenes, where the selection of starter scenes is based on a selection of a drawing activity. The Examiner asserts that this limitation is met by the selection of the image type in Clark. The mere selection of an image type is not the same as displaying a plurality of selectable starter scenes” as recited in claim 26. As described in Clark, the image type selection merely brings up the color palette to be used for editing an image provided by a user (e.g., the user downloads an image from a camera). The program of Clark does not “display a plurality of selectable starter scene” based on a selection of a drawing activity and upon receipt of a selection of a starter scene, “modifying at least one characteristic associated with an interactive tool on a toolbar” as recited in claim 26.

Accordingly, at least for this reason, claim 26 is allowable over the cited references. Based at least upon their dependence from claim 26, claims 27 and 28 are also allowable.

Claim 31 and its Dependent Claims

Claim 31 recites “a first read-only memory . . . including code associated with a first drawing activity” and “a port configured to receive a cartridge including a second removable read-only memory, the second removable read-only memory including code associated with a second drawing activity . . . the second characteristic being configured for use with the second drawing activity and not the first drawing activity.” For similar reasons as described above for claim 22, none of Hainey, Microsoft Office, Microsoft Paint, or Clark, alone or in combination, disclose or suggest such a device. Specifically, none of the cited references disclose or suggest a characteristic of an interactive tool that is configured for use with a drawing activity associated with a removable read-only memory and not configured for use with a first activity associated with a different read-only memory.

Accordingly, at least for this reason, claim 31 is allowable over the cited references. Based at least upon their dependence from claim 31, claims 57-61 are also allowable.

Claim 32 and its Dependent Claims

Claim 32 recites “each of the plurality of selectable icons associated with at least one drawing tool, each of the plurality of selectable icons being one of activated or inactivated based on an activity selected from a plurality of selectable activities.” For similar reasons as stated above for claim 1, none of Hainey, Microsoft Office, Microsoft Paint, or Clark, alone or in combination, disclose or suggest such a device. Specifically, none of the cited references disclose or suggest selectable icons that are either activated or inactivated based on the selection of a particular activity.

Accordingly, at least for this reason, claim 32 is allowable over the cited references. Based at least upon their dependence from claim 32, claims 33-41 and 62 are also allowable.

Claim 43 and its Dependent Claims

Claim 43 recites “said second interactive tool being one of activated or inactivated based on the selection of said one of said plurality of activities.” For similar reasons as stated above

for claim 1, none of Hailey, Microsoft Office, Microsoft Paint, or Clark, alone or in combination, disclose or suggest such a device. Specifically, none of the cited references disclose or suggest selectable icons that are either activated or inactivated based on the selection of a particular activity.

Accordingly, for at least this reason, claim 43 is allowable over the cited references. Based at least upon their dependence from claims 43, claims 44-51 are also allowable.

CONCLUSION

All of the stated grounds of rejection have been properly traversed or rendered moot. The Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. The Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

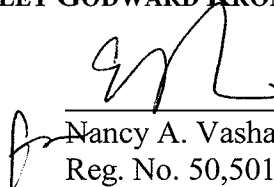
Prompt and favorable consideration of this Amendment is respectfully requested.

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